

**MAIL STOP APPEAL  
BRIEF - PATENTS**

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**  
**BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

Applicants: Sincaglia, et al. Attorney Docket No. 1224-2006012  
Application No: 09/777500 Group Art Unit: 2162  
Filed: February 5, 2001 Examiner: Ehichioya, Fred. I.  
Title: SYSTEM FOR DISTRIBUTED MEDIA NETWORK AND META DATA  
SERVER

**APPELLANT'S REPLY BRIEF**

Seattle, Washington

August 7, 2006

TO THE COMMISSIONER FOR PATENTS:

This Reply Brief is filed in response to the Examiner's Answer of June 5, 2006, and pursuant to 37 C.F.R. § 1.193(b)(1).

**Status of the Claims**

The claims remain as presented in the Appeal Brief.

**Basis for Which the Rejections Should Be overturned**

1. Rejection of Claims 9, 33 and 45 under 35 U.S.C. 61 12, first paragraph, was improper because §112, first paragraph, does not require the invention being claimed to be described *ipsis verbis* (i.e., 'in the same words'), and when Appellant's disclosure is properly viewed in totality, a person of ordinary skill will appreciate Appellant was in possession of the invention being claimed at the time of the filing of the subject application.

Appellant graciously acknowledges the Examiner's withdrawal of the 35 U.S.C. §112, first paragraph objection to the above identified claims.

2. Rejections of Claims 9-15, 18, 20-21, 23, 33-38, and 45-50 under 35 U.S.C. §103(a) were improper because when the invention being claimed is properly viewed as a whole, as required by law, the invention is not suggested by the cited references.

### Arguments

The law of §103(a) is also well settled. To establish obviousness under 35 U.S.C. §103, the Examiner must view the invention as a whole. Further, the Examiner must perform the obviousness analysis in accordance with the standard set forth by the Supreme Court in Graham v. John Deere Co. That standard requires that the Examiner (1) determine the scope and content the prior art; (2) ascertain the differences between the prior art and the claims in issue; (3) resolve the level of ordinary skill in the art; and (4) evaluate evidence of secondary considerations. 383 U.S. 1, 17-18 (1966). (See also MPEP 2141). Secondary considerations include whether the invention was met with commercial success, whether the invention answered a long felt need, and whether others attempting the invention have failed. *id.* Further in applying the Graham framework, the Examiner must consider the invention as a whole, without the benefit of hindsight (See e.g., MPEP 2141).

### Claims 9, 33 and 45

Claims 9, 33 and 45 stand rejected under §103(a) as being obvious in view of U.S. Patent 6,412,004 issued to Ling Tony Chen et al. ("*Chen*") and U.S. Patent 6,453,355 issued to Anne Jones et al. ("*Jones*") combined. Appellant respectfully disagrees.

Appellant would like to reiterate that as Claims 9, 33, and 45 include the recitation that the media data servers are separate and independently operated from the meta data server(s); these claims are not taught or suggest by *Chen* or *Jones*, alone or in combination. The claims recite that the independent operation includes without continuous observing by, and communication with the meta data server. Thus when viewed as a whole (as required by law), the invention being claimed requires a novel independent operation architecture for the meta and media servers.

In contrast, *Chen* teaches the employment of meta servers and media servers that are tightly coupled, including the continuous monitoring of the media servers by meta servers (see e.g., col. 11, lines 1 -3, and col. 6, lines 63-67 "the metaserver continuously monitors the system **including each multimedia server**"), and *Jones*

teaches the communications of a media file (having meta data interleaved therein) from an integrated web server system (see e.g., Fig. 6).

In responding to Appellant's arguments, the Examiner stated in paragraph 3 of the Final Office Action that "the metaserver can coordinate a plurality of multimedia servers located in different geographic areas" can be translated to mean "media data server being separate and independently operated from the meta data server". *Chen's* continuous monitoring requirement clearly indicates that such a translation is inappropriate.

Jones does not remedy the above discussed deficiencies of *Chen*. Thus, *Chen* and *Jones* do not teach or suggest the above discussed recitations of Claims 9, 33, and 45, individually or in combination. Therefore, for at least the above reasons, Claims 9, 33, and 45 are patentable over *Chen* and *Jones* combined.

Furthermore, the Examiner argues that *Jones* teaches retrieving meta data associated with the media data request from a meta data database, the meta data identifying a media data server having the requested media data. Even though a section of *Jones* is cited (col. 5, lines 24-29), Appellant has been unable to locate in that section or in any other section of *Jones* where *Jones* teaches "retrieving meta data associated with the media data request from a meta data database, the meta data identifying a media data server having the requested media data." The Examiner correctly notes that *Chen* does not teach these elements. Accordingly, for this reason as well, Claims 9, 33, and 45 are patentable over *Chen* and *Jones* combined.

On a further note, the Examiner's rationale for combining *Chen* and *Jones* appears to be based on *Jones* alleged teaching of an "entity different from the media service provider"; *Jones* only teaching of service providers are conventional Internet Service Providers (ISPs). The additional rationale that streaming "time related sequences" is a problem for *Chen* does not appear to be warranted, as Appellant has been unable to identify anywhere in *Chen* where such a problem expressed. The Examiner has attempted to use the pending application to define the problem to be solved by reference to different elements from the prior art. The Federal Circuit has indicated that any attempt to selectively cull from the prior art to fit a claimed invention is

prohibited. In this regard, the Board's attention is directed to the following decisions of the Federal Circuit:

When the Board does not explain the motivation, or the suggestion or teaching, that would have led the skilled artisan at the time of the invention to the claimed invention as a whole, we infer that the Board used hindsight to conclude that the invention was obvious... To reach a non-hindsight driven conclusion as to whether a person having ordinary skill in the art at the time of the invention would have viewed the subject matter as a whole to have been obvious in view of multiple references, the Board must provide some rationale, articulation, or reasoned basis to explain why the conclusion of obviousness is correct. *In re Kahn*, 441 F.3d 977, 78 U.S.P.Q.2d 1329 (2006).

[D]etermination of obviousness cannot be based on the hindsight combination of components selectively culled from the prior art to fit the parameters of the patent invention. There must be a teaching or suggestion within the prior art, within the nature of the problem to be solved, or within the general knowledge of a person of ordinary skill in the field of the invention, to look to particular sources, to select particular elements, and to combine them as combined by the inventor. *Crown Operations Intern., Ltd. v. Solutia Inc.*, 289 F.3d 1367, 62 U.S.P.Q.2d 1917 (2002).

Although the suggestion to combine references may flow from the nature of the problem, defining the problem in terms of its solution reveals improper hindsight in the selection of the prior art relevant to obviousness. Therefore, when determining the patentability of a claimed invention which combines two known elements, 'the question is whether there is something in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination'...We cannot use hindsight

reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention. *Ecolochem, Inc. v. Southern California Edison Co.*, 227 F.3d 1361, 56 U.S.P.Q.2d 1065 (2000). (quoting *Lindemann Maschinenfabrik GMBH v. American Hoist*, 730 F.2d 1452, 221 U.S.P.Q. 481 (1984)). (Emphasis added).

Obviousness may not be established using hindsight. In determining obviousness, the invention must be considered as a whole and the claims must be considered in their entirety. *Kahn v. General Motors Corp.*, 135 F.3d 1472, 45 U.S.P.Q.2d 1608 (1998).

It is impermissible...to engage in a hindsight reconstruction of the claimed invention, using the applicant's structure as a template and selecting elements from references to fill the gaps. The references themselves must provide some teaching whereby the applicant's combination would have been obvious. *In re Gorman*, 993 F.2d 982, 18 U.S.P.Q.2d 1885 (1991).

In reviewing the decisions of the Board which are based on...obviousness grounds, our focus must be whether "the differences between the subject matter sought to be patented and the prior art are such that the *subject matter as a whole* would have been obvious at the time the invention was made." *In re Kaslow*, 707 F.2d 1366, 217 U.S.P.Q. 1089 (1983).

For this reason as well, Claims 9, 33, and 45 are patentable over *Chen* and *Jones* as they should not have been combined in the first place.

#### Claims 10-15, 23, 35-38, and 47-50

In the Examiner's Answer Claims 10-15, 23, 35-38, and 47-50 stand rejected under §103(a) in view of *Chen* and *Jones*, and further in view of U.S. Patent 6,510,553 issued to Rajeeb Hazra ("*Hazra*"). The addition of *Hazra* does not remedy the above

discussed deficiencies of *Chen* and *Jones*. Claims 10-15, 23, 35-38, and 47-50 depend on either claim 9, 33 or 45, incorporating their recitations. Therefore, for at least the same reasons, Claims 10-15, 23, 35-38, and 47-50 remain patentable over *Chen* and *Jones*, even when combined with *Hazra*.

Furthermore, the alleged motivation to combine *Chen*, *Jones* and *Hazra* is incorrect. Even if data is compressed and transmitted as an audio stream, it is not at all clear that the transmission of information would be faster. As those of ordinary skill in the art will appreciate, already compressed video or audio data would not be transmitted more quickly, and would in many cases be transmitted more slowly.

Furthermore, Claims 10-15, 23, 25, 35-38, and 47-50 incorporate additional elements not taught by Claims 9, 33 or 45, or by the cited references. For example, with regard to Claim 10, *Hazra* in column 6, lines 37-42 is cited as teaching “wherein the **meta data contains an address of said media server**”; however, Appellant has been unable to locate any teaching of meta data that contains an address of a media server in the cited location or in the remainder of *Hazra* (or either *Chen* or *Jones*). Likewise, the recitation that *Hazra* also teaches “designating said media data server as a primary media data server” at col. 5, line 43-65 is similarly deficient. Further, *Hazra* also fails to teach “designating said media data server as a primary media data server, based upon at least criteria gather from a communication network between the client and the media data server.” Therefore, Claim 10 and its dependent Claims 11-15 are further patentable over *Chen*, *Jones* and *Hazra*, individually or in combination.

Similarly, with regard to Claims 23, 35 and 47 *Hazra* column 4, lines 61-67 is cited as teaching “receiving request from the client for additional meta data for the additional portion of the requested media data”; however, Appellant has been unable to locate anything of the alleged teaching in that location or in the remainder of *Hazra* (or either *Chen* or *Jones*). Therefore, Claims 23, 35 and 47 and their dependent Claims 48-50 are further patentable over *Chen*, *Jones* and *Hazra*, individually or in combination.

Therefore, for at least these reasons, Claims 10-15, 23, 25, 35-38, and 47-50 are patentable over *Chen*, *Jones* and *Hazra*, individually or in combination.



Claims 18, 21, 34, and 46

In the Examiner's Answer Claims 18, 21, 34, and 46 stand rejected under §103(a) in view of *Chen* and *Jones*, and further in view of U.S. Patent 6,385,596 issued to Philip R Wiser (*Wiser*). *Wiser* does not remedy the above discussed deficiencies of *Chen* and *Jones*. Additionally, the Examiner's suggestion of a motivation does not appear to address any deficiencies of *Chen* or *Jones* that required the addition of *Wiser*. Accordingly, it appears that this suggestion is yet another example of hindsight reasoning. Therefore, for at least the same reasons, Claims 9, 33 or 45 remain patentable over *Chen* and *Jones*, even when combined in *Wiser* and as Claims 18, 21, 34, and 46 depend on either Claim 9, 33 or 45, incorporating their recitations, Claims 18, 21, 34 and 46 are patentable over *Chen*, *Jones* and *Wiser*, individually or in combination.

Furthermore, Claims 18, 21, 34 and 46 incorporate additional elements not taught by Claims 9, 33 or 45, or by the cited references. For example, with regard to Claims 18, 34 and 46, *Wiser* column 4 lines 33-36 is cited as teaching "requesting decryption key for the requested media data from a meta data database"; however, Appellant has been unable to locate any request for a key **from a meta data database** in that location or in the remainder of *Wiser* (or either *Chen* or *Jones*). Therefore, Claims 18, 34 and 46 are further patentable over *Chen*, *Jones* and *Wiser*, individually or in combination.

Similarly, with regard to Claim 21 *Wiser* column 20, lines 19-43 is cited as teaching "a log-in request from said client device over the communications network." One of ordinary skill in the art would not confuse the "**logging**" of information to a log file as a "log-in request". Appellant has been unable to locate any relevant log-in request in *Wiser* (or either *Chen* or *Jones*). Therefore, Claim 21 is further patentable over *Chen*, *Jones* and *Wiser*, individually or in combination.

Therefore, for at least these reasons, Claims 18, 21, 34 and 46 are patentable over *Chen*, *Jones* and *Wiser*, individually or in combination.

Claim 20

In the Examiner's Answer Claim 20 stands rejected under §103(a) in view of *Chen* and *Jones*, and further in view of U.S. Patent 6,209,787 issued to Takahito Iida ("*Iida*"). *Iida* does not remedy the above discussed deficiencies of *Chen* and *Jones*. Therefore, for at least the same reasons (e.g., Iida still does not teach media data servers are separate and independently operated from the meta data server), Claim 9 remains patentable over *Chen* and *Jones*, even when combined in *Iida*. Claim 20 depends on claim 9 incorporating its recitations. Therefore, for at least the same reasons, Claim 20 is patentable over *Chen*, *Jones* and *Iida*, individually or in combination.

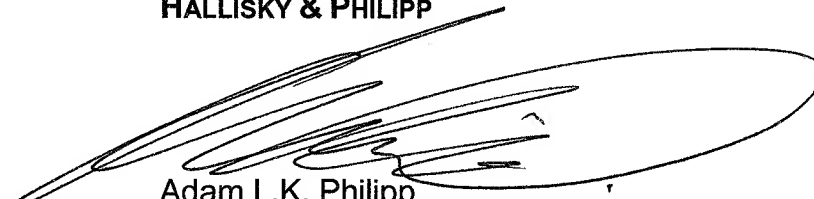
Furthermore, The Examiner's reasons given for combining *Iida* with *Chen* and *Jones* is seriously deficient as it cites to a rationale pertaining to the combination of the encryption of *Wiser* and *Chen* and no rationale is given for combining *Iida* with *Chen* and/or *Jones*. Therefore, given no motivation, it would be improper to combine *Chen*, *Jones* and *Iida*. For this reason as well, Claim 20 is patentable over *Chen*, *Jones* and *Iida*.

Conclusion

Appellant respectfully submits that all the appealed claims in this application are patentable and requests that the Board of Patent Appeals and Interferences overrule the Examiner and direct allowance of the rejected claims.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is invited to contact Adam Philipp, Reg. No. 42,071 at the telephone number of the undersigned below.

Kind regards,  
**HALLISKY & PHILIPP**



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I hereby certify that this correspondence is being electronically transmitted to the United States Patent and Trademark Office on the date indicated below.

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